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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,155	11/25/2003	Valdemar Portney	L-1632CA	5547

7590 02/24/2005  
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EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/721,155

Applicant(s)

PORTNEY, VALDEMAR

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,5,8,9,11,12,14 and 16-42 is/are pending in the application.
- 4a) Of the above claim(s) 9,11,12,14,16-20 and 30-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8 and 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Death of Attorney***

In view of the notification of the death of the attorney or agent of record, the power of attorney is terminated. A new registered attorney or agent may be appointed. Until so, correspondence is being sent to the applicant.

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-35, and species 1, claims 1, 4-8, and 21-29 in the reply filed on January 13, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). (However, it is noted that the applicant has canceled claims 6-7 in the amendment, which seemingly belonged to another embodiment, therefore, the examiner has only examined claims 1, 4-5, 8, and 21-29).

Claims 9, 11-12, 14, 16-20, and 30-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Providing proper support for the terminology "thin slit formed in and through the primary lens optic **generally tangential to the anterior surface of said optic**".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-5, 8, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said preliminary intraocular lens" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "preliminary" to recite --primary--. Claims 4-5 and 8 depend upon claim 1 and inherit all problems associated with the claim.

Claim 27 recites the limitation "said preliminary intraocular lens" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "preliminary" to recite --primary--. Claims 28-29 depend upon claims 27 and inherit all problems associated with the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Portney (US 6,197,058 B1). Portney discloses a secondary IOL (64a; see fig.4, 7) having a plurality of tabs (80a) that taper to a free end (seen in fig.3, 4, 5, 6, 8), the tabs having positioning holes (88), and the IOL having the dimensions (col.3, lines 26-27), power (col.3, lines 22-26), and made of the materials (col.3, lines 2-4) claimed.

Claims 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Feaster (US 5,098,444). Feaster discloses a primary IOL (221; seen in fig.20, 29, 30) comprising an optic (221), peripheral edge, anterior surface (top surface), posterior surface (bottom surface), power (col.21, lines 3-5; col.18, lines 4-13), and at least one slit (227) formed in and through the optic adjacent the edge of the optic (seen in fig.29, 30; col.19 line 51-col.20 line 21), and also an attachment means (223) fixed to the IOL (fig.20-23). Feaster discloses the IOL to comprise a dual optic IOL (fig.29, 30, the second optic being 301).

Claims 1, 8, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Werblin et al. (US 5,968,094). See figures 6-8 and respective portions of the specification. Werblin discloses a IOL system (fig.8a, 8b) comprising a primary IOL (seen in fig.6a, 6b) having a slit (see attachment 1) formed in and through the lens optic generally tangential to the anterior surface, and having attachment means fixed to the optic (haptics seen in fig.6a), Werblin also discloses a secondary IOL (fig.7a,7b) having a narrow attachment tab (see attachment 2) extending generally radially outward to penetrate the slit of the primary IOL (fig.8a, 8b). Werblin discloses a thickness claimed (col.5, lines 11-17; 1.88 mm comprises at least three

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pieces, therefore, one piece would have the thickness claimed). Werblin discloses a dual optic system (fig.8).

Claims 1, 4, 5, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (US 6,113,633). Referring to claims 1, 4, and 5, Portney discloses an IOL system comprising a primary IOL (11, seen in fig.5) having an anterior surface (37 *or* 31), posterior surface (33), peripheral edge, power, and a thin slit (opening 34) formed in and through the lens optic *generally* tangential to the anterior surface of the optic (seen in fig.6, 7, 5), and an attachment means (26) fixed to the optic, and further a secondary IOL (32) having optic with an anterior surface, posterior surface, peripheral edge, and an attachment tab (reduced thickness area; col.3, lines 32-36; see attachment 3) extending generally radially outward from the edge, sized to penetrate the slit on the primary IOL (fig.6-8), wherein the secondary IOL posterior surface is lying against the primary IOL anterior surface (fig.7, 8). Portney discloses the secondary IOL to have a plurality of tabs (col.5, lines 19-25), the tabs being tapered (col.3, lines 32-36; fig.6, 8).

Referring to claims 27 and 29, Portney discloses a primary IOL (11) comprising an optic having an edge, anterior surface (31), posterior surface (33), power, and at least one slit (34; entire pocket plus the openings) formed in and through the primary IOL adjacent the edge (see attachment 4), and an attachment means (26) fixed to the optic. Portney discloses a dual optic system (fig.7, 8).

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Claims 1, 4, 8, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US 4,842,601). Smith discloses an IOL system (130; see fig.11 and respective portions of the specification) comprising a primary IOL (132) having an anterior surface (132a+38b), posterior surface (132b), peripheral edge (38), power (col.8, lines 29-50), and a thin slit (40; see attachment 5) formed in and through the lens optic *generally* tangential to the anterior surface of the optic (slit may have angled walls; col.6, lines 19-23), and an attachment means (outermost edge may serve as an attachment means, or 54 may be considered an attachment means) fixed to the optic, and further a secondary IOL (134) having optic with an anterior surface (134b), posterior surface (134a), peripheral edge, and an attachment tab (reduced thickness area fig.11, which contacts the primary IOL) extending generally radially outward from the edge, sized to penetrate the slit on the primary IOL (fig.11, 8), wherein the secondary IOL posterior surface is lying against the primary IOL anterior surface (fig.11, see attachment 5, 6 ).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feaster (US 5,098,444). Referring to claim 21, (see fig.28, 29) Feaster discloses a secondary IOL (291, 301) having an anterior surface (top surface), posterior surface (bottom surface), peripheral edge, a power (col.21, lines 1-4), and an attachment tab (293, 303) extending

generally radially from the edge (loops around edge of a primary lens, and therefore, first extends radially outward, see fig.28, 29), the tab tapered to an end (seen in fig.28, 29; taper on secondary lenses, col.13, lines 12-15; col.20, lines 15-18). Feaster has shown the lens to have a thickness (seen in figs), however is silent to mention any specific dimensions. It would have been an obvious matter of design choice to have a thickness of 0.1-0.4mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Referring to claims 22-24, Feaster discloses a plurality of tabs (spaced apart clips, col.19, lines 51-56), and the IOL to be made of silicones or acrylics (col.19, lines 41-43, 57-58).

Referring to claim 28, Feaster discloses a primary IOL (291, 221) substantially as claimed, having a power (col.18, lines 4-13), and slit dimensions as seen in the figures (fig.29, 30; see discussion above). Feaster does not disclose the specific power range, and dimensions claimed, however the dimensions and power would have been obvious to one having ordinary skill in the art at the time the invention was made since when the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

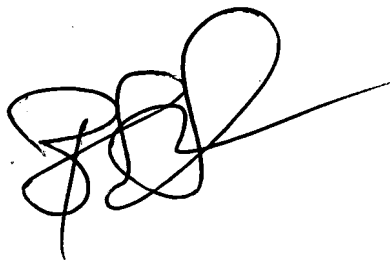
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER